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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,774	12/09/2003	Markus Stolze	CH920020035US1	4804
48233 7590 05/29/2008 SCULLY, SCOTT, MURPHY & PRESSER, P.C. 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
PATEL, HARESH N				
ART UNIT		PAPER NUMBER		
2154				
MAIL DATE		DELIVERY MODE		
05/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/730,774

**Applicant(s)**

STOLZE, MARKUS

**Examiner**

Haresh N. Patel

**Art Unit**

2154

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-7,10-12,16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,10-12 and 16 is/are rejected.
- 7) ☒ Claim(s) 18-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-3, 5-7, 10-12, 16, 18-20 are subject to examination. Claims 18-20 are allowable but objected to.

#### ***Specification***

2. The title of the invention dated 1/22/2008 is acknowledged.

#### ***Drawings***

3. The drawing dated 1/22/2008 is acknowledged.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.  
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-3, 5-7, 10-12, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tafoya et al. 6,829,607, Microsoft Corporation, (Hereinafter Tafoya-Microsoft) in view of "Official Notice".

6. Referring to claim 1, Tafoya-Microsoft discloses a method executed in a computer system for completing an address (e.g., col., 4), the method comprising the steps of: detecting an incomplete input of the address (e.g., col., 4); deriving a completion offer to said input based on a determined score (e.g., col., 4); and offering the derived completion offer for completing the address (e.g., col., 5), wherein said score is determined as a combination of base score and context dependent address score (e.g., col., 11); wherein said base score is determined from the content of one or more of: a user's organizational context records, a user's address book, a user's incoming or outgoing mail records, a user's address records (e.g., col., 12); and, wherein the context dependent address score is derived from the base score and from one or more of: a user typed address fragments, recently opened addresses, addresses used in recent communications, and recent completion corrections (e.g., col., 11). However Tafoya-Microsoft does not specifically mention about the offer being string. "Official Notice" is taken that both the concept and advantages of providing string for the offer is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include string with the teachings of Tafoya-Microsoft in order to facilitate usage of the string because it would enhance providing characters for the address. The user would utilized character information provided by the string.

7. Referring to claim 2, Tafoya-Microsoft discloses the claimed limitations as rejected above. Tafoya-Microsoft also discloses wherein the completion offer comprises a list of address completions, the list is ordered in accordance with the determined score (e.g., col., 5).

8. Referring to claim 3, Tafoya-Microsoft discloses the claimed limitations as rejected above. Tafoya-Microsoft also discloses wherein the step of offering comprises presenting the list of address completions (e.g., col., 6).

9. Referring to claim 5, Tafoya-Microsoft discloses the claimed limitations as rejected above. Tafoya-Microsoft also discloses wherein the determined score is a context dependent address score (e.g., col., 7).

10. Referring to claim 6, Tafoya-Microsoft discloses the claimed limitations as rejected above. Tafoya-Microsoft also discloses wherein the step of deriving comprises defining at least one possible address based on the incomplete user input (e.g., col., 8).

11. Referring to claim 7, Tafoya-Microsoft discloses the claimed limitations as rejected above. Tafoya-Microsoft also discloses wherein the step of deriving further comprises assigning one context dependent address score to each possible address, and including each possible address in the completion offer sorted in accordance with the assigned context dependent address score (e.g., col., 10).

12. Referring to claim 10, Tafoya-Microsoft discloses the claimed limitations as rejected above. Tafoya-Microsoft also discloses wherein the base score decreases over time and thereby influences the determined score (e.g., col., 14).

13. Referring to claim 11, Tafoya-Microsoft discloses the claimed limitations as rejected above. Tafoya-Microsoft also discloses wherein the address is one of a mail address, an e-mail address, or a phone number (e.g., col., 9).

14. Referring to claim 12, Tafoya-Microsoft discloses the claimed limitations as rejected above. Tafoya-Microsoft also discloses program storage device tangibly embodying a program of instructions executable by at least one processor for performing the method of detecting an incomplete input of the address; deriving a completion string to said input based on a determined score; and offering the derived completion string for completing the address (e.g., col., 4).

15. Referring to claim 16, Tafoya-Microsoft discloses the claimed limitations as rejected above. Tafoya-Microsoft also discloses an apparatus for completing an address (e.g., col., 4), the apparatus comprising: means for detecting an incomplete input of the address (e.g., col., 4); means for deriving a completion offer to said input based on a determined score (e.g., col., 4); and means for offering the derived completion offer for completing the address (e.g., col., 5).

16. Claims 1-3, 5-7, 10-12, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plow et al. 2003/0028792, IBM, (Hereinafter Plow-IBM) in view of "Official Notice".

17. Referring to claim 1, Tafoya-Microsoft discloses a method executed in a computer system for completing an address (e.g., page 3), the method comprising the steps of: detecting an incomplete input of the address (e.g., page 3); deriving a completion offer to said input based on

a determined score (e.g., page 3); and offering the derived completion offer for completing the address (e.g., page 2), wherein said score is determined as a combination of base score and context dependent address score (e.g., page 3); wherein said base score is determined from the content of one or more of: a user's organizational context records, a user's address book, a user's incoming or outgoing mail records, a user's address records (e.g., page 2); and, wherein the context dependent address score is derived from the base score and from one or more of: a user typed address fragments, recently opened addresses, addresses used in recent communications, and recent completion corrections (e.g., page 3). However Tafoya-Microsoft does not specifically mention about the offer being string. "Official Notice" is taken that both the concept and advantages of providing string for the offer is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include string with the teachings of Tafoya-Microsoft in order to facilitate usage of the string because it would enhance providing characters for the address. The user would utilized character information provided by the string.

18. Referring to claim 2, Plow-IBM discloses the claimed limitations as rejected above. Plow-IBM also discloses wherein the completion offer comprises a list of address completions, the list is ordered in accordance with the determined score (e.g., page 3).

19. Referring to claim 3, Plow-IBM discloses the claimed limitations as rejected above. Plow-IBM also discloses wherein the step of offering comprises presenting the list of address completions (e.g., page 3).

20. Referring to claim 5, Plow-IBM discloses the claimed limitations as rejected above. Plow-IBM also discloses wherein the determined score is a context dependent address score (e.g., page 3).

21. Referring to claim 6, Plow-IBM discloses the claimed limitations as rejected above. Plow-IBM also discloses wherein the step of deriving comprises defining at least one possible address based on the incomplete user input (e.g., page 3).

22. Referring to claim 7, Plow-IBM discloses the claimed limitations as rejected above. Plow-IBM also discloses wherein the step of deriving further comprises assigning one context dependent address score to each possible address, and including each possible address in the completion offer sorted in accordance with the assigned context dependent address score (e.g., page 3).

23. Referring to claim 10, Plow-IBM discloses the claimed limitations as rejected above. Plow-IBM also discloses wherein the base score decreases over time and thereby influences the determined score (e.g., page 3).

24. Referring to claim 11, Plow-IBM discloses the claimed limitations as rejected above. Plow-IBM also discloses wherein the address is one of a mail address, an e-mail address, or a phone number (e.g., page 3).



25. Referring to claim 12, Plow-IBM discloses the claimed limitations as rejected above. Plow-IBM also discloses a computer program element comprising program code means for performing the method of claim 1 when said program is run on a computer (e.g., page 2).

26. Referring to claim 16, Plow-IBM discloses the claimed limitations as rejected above. Plow-IBM also discloses an apparatus for completing an address (e.g., page 2), the apparatus comprising: means for detecting an incomplete input of the address (e.g., page 2); means for deriving a completion offer to said input based on a determined score (e.g., page 2); and means for offering the derived completion offer for completing the address (e.g., page 2).

27. Claims 1-3, 5-7, 10-12, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2002//0057678 (Hereinafter Jiang) in view of "Official Notice".

28. Referring to claim 1, Tafoya-Microsoft discloses a method executed in a computer system for completing an address (e.g., page 21), the method comprising the steps of: detecting an incomplete input of the address (e.g., page 21); deriving a completion offer to said input based on a determined score (e.g., page 21); and offering the derived completion offer for completing the address (e.g., page 20), wherein said score is determined as a combination of base score and context dependent address score (e.g., page 21); wherein said base score is determined from the content of one or more of: a user's organizational context records, a user's address book, a user's incoming or outgoing mail records, a user's address records (e.g., page 20); and, wherein the

context dependent address score is derived from the base score and from one or more of: a user typed address fragments, recently opened addresses, addresses used in recent communications, and recent completion corrections (e.g., page 21). However Tafoya-Microsoft does not specifically mention about the offer being string. “Official Notice” is taken that both the concept and advantages of providing string for the offer is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include string with the teachings of Tafoya-Microsoft in order to facilitate usage of the string because it would enhance providing characters for the address. The user would utilized character information provided by the string.

29. Referring to claim 2, Jiang discloses the claimed limitations as rejected above. Jiang also discloses wherein the completion offer comprises a list of address completions, the list is ordered in accordance with the determined score (e.g., page 21).

30. Referring to claim 3, Jiang discloses the claimed limitations as rejected above. Jiang also discloses wherein the step of offering comprises presenting the list of address completions (e.g., page 21).

31. Referring to claim 5, Jiang discloses the claimed limitations as rejected above. Jiang also discloses wherein the determined score is a context dependent address score (e.g., page 21).

32. Referring to claim 6, Jiang discloses the claimed limitations as rejected above. Jiang also discloses wherein the step of deriving comprises defining at least one possible address based on the incomplete user input (e.g., page 21).

33. Referring to claim 7, Jiang discloses the claimed limitations as rejected above. Jiang also discloses wherein the step of deriving further comprises assigning one context dependent address score to each possible address, and including each possible address in the completion offer sorted in accordance with the assigned context dependent address score (e.g., page 21).

34. Referring to claim 10, Jiang discloses the claimed limitations as rejected above. Jiang also discloses wherein the base score decreases over time and thereby influences the determined score (e.g., page 21).

35. Referring to claim 11, Jiang discloses the claimed limitations as rejected above. Jiang also discloses wherein the address is one of a mail address, an e-mail address, or a phone number (e.g., page 21).

36. Referring to claim 12, Jiang discloses the claimed limitations as rejected above. Jiang also discloses program storage device tangibly embodying a program of instructions executable by at least one processor for performing the method of detecting an incomplete input of the address; deriving a completion string to said input based on a determined score; and offering the derived completion string for completing the address; (e.g., page 20).

37. Referring to claim 16, Jiang discloses the claimed limitations as rejected above. Jiang also discloses an apparatus for completing an address (e.g., page 20), the apparatus comprising: means for detecting an incomplete input of the address (e.g., page 21); means for deriving a completion offer to said input based on a determined score (e.g., page 21); and means for offering the derived completion offer for completing the address (e.g., page 21).

38. Claims 1-3, 5-7, 10-12, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cortright et al. 6,895,426, Microsoft Corporation, (Hereinafter Cortright-Microsoft) in view of "Official Notice".

39. Referring to claim 1, Cortright-Microsoft discloses a method executed in a computer system for completing an address (e.g., col., 4), the method comprising the steps of: detecting an incomplete input of the address (e.g., col., 4); deriving a completion offer to said input based on a determined score (e.g., col., 4); and offering the derived completion offer for completing the address (e.g., col., 5), wherein said score is determined as a combination of base score and context dependent address score (e.g., col., 8); wherein said base score is determined from the content of one or more of: a user's organizational context records, a user's address book, a user's incoming or outgoing mail records, a user's address records (e.g., col., 8); and, wherein the context dependent address score is derived from the base score and from one or more of: a user typed address fragments, recently opened addresses, addresses used in recent communications,

and recent completion corrections (e.g., col., 9). However Tafoya-Microsoft does not specifically mention about the offer being string. “Official Notice” is taken that both the concept and advantages of providing string for the offer is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include string with the teachings of Tafoya-Microsoft in order to facilitate usage of the string because it would enhance providing characters for the address. The user would utilized character information provided by the string.

40. Referring to claim 2, Cortright-Microsoft discloses the claimed limitations as rejected above. Cortright-Microsoft also discloses wherein the completion offer comprises a list of address completions, the list is ordered in accordance with the determined score (e.g., col., 5).

41. Referring to claim 3, Cortright-Microsoft discloses the claimed limitations as rejected above. Cortright-Microsoft also discloses wherein the step of offering comprises presenting the list of address completions (e.g., col., 6).

42. Referring to claim 5, Cortright-Microsoft discloses the claimed limitations as rejected above. Cortright-Microsoft also discloses wherein the determined score is a context dependent address score (e.g., col., 7).

43. Referring to claim 6, Cortright-Microsoft discloses the claimed limitations as rejected above. Cortright-Microsoft also discloses wherein the step of deriving comprises defining at least one possible address based on the incomplete user input (e.g., col., 8).

44. Referring to claim 7, Cortright-Microsoft discloses the claimed limitations as rejected above. Cortright-Microsoft also discloses wherein the step of deriving further comprises assigning one context dependent address score to each possible address, and including each possible address in the completion offer sorted in accordance with the assigned context dependent address score (e.g., col., 10).

45. Referring to claim 10, Cortright-Microsoft discloses the claimed limitations as rejected above. Cortright-Microsoft also discloses wherein the base score decreases over time and thereby influences the determined score (e.g., col., 8).

46. Referring to claim 11, Cortright-Microsoft discloses the claimed limitations as rejected above. Cortright-Microsoft also discloses wherein the address is one of a mail address, an e-mail address, or a phone number (e.g., col., 9).

47. Referring to claim 12, Cortright-Microsoft discloses the claimed limitations as rejected above. Cortright-Microsoft also discloses program storage device tangibly embodying a program of instructions executable by at least one processor for performing the method of detecting an

incomplete input of the address; deriving a completion string to said input based on a determined score; and offering the derived completion string for completing the address (e.g., col., 7).

48. Referring to claim 16, Cortright-Microsoft discloses the claimed limitations as rejected above. Cortright-Microsoft also discloses an apparatus for completing an address (e.g., col., 4), the apparatus comprising: means for detecting an incomplete input of the address (e.g., col., 4); means for deriving a completion offer to said input based on a determined score (e.g., col., 4); and means for offering the derived completion offer for completing the address (e.g., col., 5).

#### ***Allowable Subject Matter***

49. Claims 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

50. Applicant's arguments filed 1/22/2008, pages 9-15, have been fully considered but they are not persuasive. Therefore, rejection of claims is maintained.

Regarding the applicant's concern, Tafoya allegedly teaches a method for facilitating user input of email addresses by automatically providing dynamically generated completion offer based upon many considerations and their combinations. The method, for suggesting of an address in Tafoya is mostly structured around determining the weight, i.e., the highest probability of an address to be used. This weight is determined by calculations based in most part

on the number of days since such address was last used (Tafoya, Page 10, Paragraph 45); It appears to the applicants that Plow discloses a method for automatically inputting user information to an electronic form provided to a user in various e-commerce processes and while filling out on-line applications. (Plow; pages 2 - 4); It appears to the applicants that Jiang discloses a method for auto filling a form based on what was previously entered by a user. When applying such method for auto filling an email address field, user preferences and application domain settings are taken into consideration. (Jiang; pages 20, paragraph 300); It appears to the applicants that Cortright discloses a method for automatically inputting user information to an electronic form provided to a user in various processes of e-commerce and while filling out on-line applications. (Cortright, col 7); the examiner respectfully disagrees. The relied upon disclosure and the teachings of the cited references are not limited as concluded by the applicant. The cited references disclose the broadly claimed limitations, i.e., please see the cited portions among other places of the cited art that not only contain the applicant concerned content of the art but also the relied upon limitations. The specification of the application under prosecution at page 15, states, It is noted that the foregoing has outlined some of the more pertinent objects and embodiments of the present invention. This invention may be used for many applications. Thus, although the description is made for particular arrangements and methods, the intent and concept of the invention is suitable and applicable to other arrangements and applications. It will be clear to those skilled in the art that modifications to the disclosed embodiments can be effected without departing from the spirit and scope of the invention. The described embodiments ought to be construed to be merely illustrative of some of the more prominent features and applications of the invention. Other beneficial results can be realized by applying the disclosed invention in a



different manner or modifying the invention in ways known to those familiar with the art. Further, when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. **In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963).** Skill in the art is presumed. **In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985).** Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. **In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).**

### *Conclusion*

Multiple references are used for the rejections to demonstrate that several references disclose the broadly claimed subject matter of the claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Haresh N. Patel/

Primary Examiner, Art Unit 2154

5/24/2008